

Criteria for a Rejection under 35 U.S.C. § 103(a)

The U.S. Patent and Trademark Office has set forth a methodology for establishing a *prima facie* case of obviousness. Specifically, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP 706.02 (j).

Applicant believes Examiner has failed to establish a *prima facie* case of obviousness because none of the cited references discloses or suggests the limitations set out in the claims.

Below, Applicant discusses limitations in each claim which are not disclosed or suggested by Newman, Pickover or a combination of Newman and Pickover. On the basis of this, Applicant believes the Examiner has failed to establish a *prima facie* case of obviousness. Since there is no *prima facie* case of obviousness, Applicant believes all the claims in the case should be allowable.

Discussion of Independent Claim 1

Claim 1 sets out a method for printing a URL page by a computing system. This is subject matter not disclosed or suggested by Newman or Pickover.

Newman sets out a method and apparatus for implementing universal resource locator menus. Newman does not provide any information pertaining to the printing of a URL page.

Pickover sets out an iconic subscription schedule controller for a graphic user interface. Pickover does not provide any information pertaining to the printing of a URL page.

Since neither Newman nor Pickover disclose or suggest printing out URL pages, no combination of Newman and Pickover will disclose or suggest printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of Newman and Pickover.

Step (a) of claim 1:

Step (a) of claim 1, indicates a reference to a URL address is dragged and dropped upon a print icon. This subject matter is not disclosed or suggested by Newman or Pickover.

Examiner has cited Newman at the Abstract and column 6, lines 13 through 63 as disclosing step (a) of claim 1. This is incorrect. At the Abstract and column 6, lines 13 through 63, Newman discusses creating a link to a picture or a text. Newman does not disclose any information related to a print icon or dragging and dropping a URL address upon a print icon, as set out in step (a) of claim 1.

Examiner has cited Pickover at column 3, lines 8 through 32 and column 4, lines 13 through 50 as teaching that a reference to a URL address is

dragged and dropped upon a print icon. This is incorrect. At column 3, lines 8 through 32, Pickover discusses creating iconic shortcuts on a desktop GUI. At column 4, lines 13 through 50, Pickover discusses dragging an icon over a schedule controller icon. Pickover does not disclose or suggest dragging and dropping a URL address upon a print icon, as set out in step (a) of claim 1.

Substep (a.1) of claim 1:

In step (a.1), the URL page is accessed from an Internet network. This subject matter is not disclosed or suggested by Newman or Pickover.

Examiner has suggested step (a.1) is disclosed by Newman at column 8, lines 20 through 67. This is incorrect. At column 8, lines 20 through 67, Newman is discussing a variety of topics pertaining to displaying a cascaded nested menu to a user and creating links. Nothing in this section of Newman discloses or suggests accessing a URL page from an Internet network as a result of dragging and dropping a reference to a URL address upon a print icon, as set out in substep (a.1) of claim 1.

Substep (a.2) of claim 1:

In substep (a.2), the URL page is printed on a printer. Substep (a.1) and substep (a.2) are performed without displaying the URL page to a user of the computing system. This subject matter is not disclosed or suggested by Newman or Pickover.

Examiner has suggested step (a.2) is disclosed by Newman at column 8, lines 20 through 67. This is incorrect. At column 8, lines 20 through 67

Newman is discussing a variety of topics pertaining to displaying a cascaded nested menu to a user and creating links. Nothing in this section of Newman discloses or suggests a URL page is printed on a printer, as set out in substep (a.2) of claim 1. Nothing in this section of Newman discloses or suggests printing a URL page without displaying the URL page to a user of the computing system, as set out in claim 1.

Chart

The chart below summarizes the limitations of independent claim 1 not found in Newman or Pickover.

Subject matter in claim 1	Newman	Pickover
Preamble: Printing a URL page	Does not disclose printing a URL page	Does not disclose printing a URL page
Step (a): Drag and drop a URL address upon a print icon	Does not disclose drag and drop of a URL address upon a print icon	Does not disclose drag and drop of a URL address upon a print icon
Substep (a.1): Accessing a URL page when a drag and drop is performed	Newman does not access the URL page upon a drag and drop operation	Pickover does not access the URL page upon a drag and drop operation
Substep (a.2): Printing a URL page on a printer	Does not disclose printing a URL page on a printer	Does not disclose printing a URL page on a printer
Printing a URL page without displaying the URL page to a user of the computing system	Does not disclose printing a URL page without displaying the URL page to a user of the computing system	Does not disclose printing a URL page without displaying the URL page to a user of the computing system

Essentially none of the pertinent subject matter of claim 1 is disclosed or suggested by Newman or Pickover. Neither of these references address any of the issues involved in printing a URL page nor does either reference

address what is necessary to implement a drag and drop feature of a URL address over a print icon.

Since none of the disclosed limitations of claim 1 are disclosed in either Newman or Pickover, it is clear that any combination of Newman and Pickover will not contain these limitations. These limitations are only disclosed through Applicant's disclosure and not from Newman, Pickover or any combination of Newman and Pickover.

Applicant believes it is clear that Examiner has failed to establish a *prima facie* case of obviousness. That is Examiner has failed to satisfy the third criteria for establishing a *prima facie* case of obviousness that states: "the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Discussion of Independent Claim 8

Claim 8 sets out a method for printing a URL page by a computing system. This is subject matter not disclosed or suggested by Newman or Pickover.

Newman sets out a method and apparatus for implementing universal resource locator menus. Newman does not provide any information pertaining to the printing of a URL page.

Pickover sets out an iconic subscription schedule controller for a graphic user interface. Pickover does not provide any information pertaining to the printing of a URL page.

Since neither Newman nor Pickover disclose or suggest printing out URL pages, no combination of Newman and Pickover will disclose or suggest printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of Newman and Pickover.

Step (a) of claim 8:

Step (a) of claim 8 indicates a reference to a URL address is dragged and dropped upon a desktop for the computing system. This subject matter is not disclosed or suggested by Newman or Pickover.

Examiner has cited Newman at the Abstract and column 6, lines 13 through 63 as disclosing step (a) of claim 8. This is incorrect. At the Abstract and column 6, lines 13 through 63, Newman discusses creating a link to a picture or a text. Newman does not disclose any information related to a print icon or dragging and dropping a URL address upon a print icon, as set out in step (a) of claim 8.

Examiner has cited Pickover at column 3, lines 8 through 32 and column 4, lines 13 through 50 as teaching that a reference to a URL address is dragged and dropped upon a print icon. This is incorrect. At column 3, lines 8 through 32, Pickover discusses creating iconic shortcuts on a desktop GUI. At column 4, lines 13 through 50, Pickover discusses dragging an icon over a schedule controller icon. Pickover does not disclose or suggest dragging and dropping a URL address upon a print icon, as set out in step (a) of claim 8.

Step (b) of claim 8:

In step (b), upon a user performing a function to activate a special icon, the URL page is printed. This is no disclosed or suggested by Newman or Pickover. As discussed above, neither Newman nor Pickover disclose or suggest printing out URL pages; therefore, no combination of Newman and Pickover will disclose or suggest printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of Newman and Pickover.

Since the limitations of claim 8 are not disclosed in either Newman or Pickover, it is clear that any combination of Newman and Pickover will not contain these limitations. These limitations are only disclosed through Applicant's disclosure and not from Newman, Pickover or any combination of Newman and Pickover.

Applicant believes it is clear that Examiner has failed to establish a *prima facie* case of obviousness. That is, Examiner has failed to satisfy the third criteria for establishing a *prima facie* case of obviousness that states: "the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Discussion of Independent Claim 16

Claim 16 sets out computer readable medium containing software which, when executed, performs a method for printing a URL page by a computing system. This is subject matter not disclosed or suggested by Newman or Pickover.

Newman sets out a method and apparatus for implementing universal resource locator menus. Newman does not provide any information pertaining to the printing of a URL page.

Pickover sets out an iconic subscription schedule controller for a graphic user interface. Pickover does not provide any information pertaining to the printing of a URL page.

Since neither Newman nor Pickover disclose or suggest printing out URL pages, no combination of Newman and Pickover will disclose or suggest printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of Newman and Pickover.

Step (a) of claim 16:

Step (a) of claim 16 indicates a reference to a URL address is dragged and dropped upon a print icon. This subject matter is not disclosed or suggested by Newman or Pickover.

Examiner has cited Newman at the Abstract and column 6, lines 13 through 63 as disclosing step (a) of claim 16. This is incorrect. At the Abstract and column 6, lines 13 through 63, Newman discusses creating a link to a picture or a text. Newman does not disclose any information related to a print icon or dragging and dropping a URL address upon a print icon, as set out in step (a) of claim 16.

Examiner has cited Pickover at column 3, lines 8 through 32 and column 4, lines 13 through 50 as teaching that a reference to a URL address is

dragged and dropped upon a print icon. This is incorrect. At column 3, lines 8 through 32, Pickover discusses creating iconic shortcuts on a desktop GUI. At column 4, lines 13 through 50, Pickover discusses dragging an icon over a schedule controller icon. Pickover does not disclose or suggest dragging and dropping a URL address upon a print icon, as set out in step (a) of claim 16.

Substep (a.1) of claim 16:

In step (a.1), the URL page is accessed from an Internet network. This subject matter is not disclosed or suggested by Newman or Pickover.

Examiner has suggested step (a.1) is disclosed by Newman at column 8, lines 20 through 67. This is incorrect. At column 8, lines 20 through 67 Newman is discussing a variety of topics pertaining to displaying a cascaded nested menu to a user and creating links. Nothing in this section of Newman discloses or suggests accessing a URL page from an Internet network as a result of dragging and dropping a reference to a URL address upon a print icon, as set out in substep (a.1) of claim 16.

Substep (a.2) of claim 16:

In substep (a.2), the URL page is printed on a printer. Substep (a.1) and substep (a.2) are performed without displaying the URL page to a user of the computing system. This subject matter is not disclosed or suggested by Newman or Pickover.

Examiner has suggested step (a.2) is disclosed by Newman at column 8, lines 20 through 67. This is incorrect. At column 8, lines 20 through 67

Newman is discussing a variety of topics pertaining to displaying a cascaded nested menu to a user and creating links. Nothing in this section of Newman discloses or suggests a URL page is printed on a printer, as set out in substep (a.2) of claim 1. Nothing in this section of Newman discloses or suggests printing a URL page without displaying the URL page to a user of the computing system, as set out in claim 16.

Since none of the disclosed limitations of claim 16 are disclosed in either Newman or Pickover, it is clear that any combination of Newman and Pickover will not contain these limitations. These limitations are only disclosed through Applicant's disclosure and not from Newman, Pickover or any combination of Newman and Pickover.

Applicant believes it is clear that Examiner has failed to establish a *prima facie* case of obviousness. That is Examiner has failed to satisfy the third criteria for establishing a *prima facie* case of obviousness that states: "the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Discussion of Independent Claim 19

Claim 19 sets out computer readable medium containing software which, when executed, performs a method for printing a URL page by a computing system. This is subject matter not disclosed or suggested by Newman or Pickover.

Newman sets out a method and apparatus for implementing universal resource locator menus. Newman does not provide any information pertaining to the printing of a URL page.

Pickover sets out an iconic subscription schedule controller for a graphic user interface. Pickover does not provide any information pertaining to the printing of a URL page.

Since neither Newman nor Pickover disclose or suggest printing out URL pages, no combination of Newman and Pickover will disclose or suggest printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of Newman and Pickover.

Step (a) of claim 19:

Step (a) of claim 19 indicates a reference to a URL address is dragged and dropped upon a desktop for the computing system. This subject matter is not disclosed or suggested by Newman or Pickover.

Examiner has cited Newman at the Abstract and column 6, lines 13 through 63 as disclosing step (a) of claim 19. This is incorrect. At the Abstract and column 6, lines 13 through 63, Newman discusses creating a link to a picture or a text. Newman does not disclose any information related to a print icon or dragging and dropping a URL address upon a print icon, as set out in step (a) of claim 8.

Examiner has cited Pickover at column 3, lines 8 through 32 and column 4, lines 13 through 50 as teaching that a reference to a URL address is

dragged and dropped upon a print icon. This is incorrect. At column 3, lines 8 through 32, Pickover discusses creating iconic shortcuts on a desktop GUI. At column 4, lines 13 through 50, Pickover discusses dragging an icon over a schedule controller icon. Pickover does not disclose or suggest dragging and dropping a URL address upon a print icon, as set out in step (a) of claim 19.

Step (b) of claim 19:

In step (b), upon a user performing a function to activate a special icon, the URL page is printed. This is no disclosed or suggested by Newman or Pickover. As discussed above, neither Newman nor Pickover disclose or suggest printing out URL pages; therefore, no combination of Newman and Pickover will disclose or suggest printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of Newman and Pickover.

Since the limitations of claim 19 are not disclosed in either Newman or Pickover, it is clear that any combination of Newman and Pickover will not contain these limitations. These limitations are only disclosed through Applicant's disclosure and not from Newman, Pickover or any combination of Newman and Pickover.

Applicant believes it is clear that Examiner has failed to establish a *prima facie* case of obviousness. That is, Examiner has failed to satisfy the third criteria for establishing a *prima facie* case of obviousness that states: "the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Conclusion

Applicant believes that the present Application is in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,
KENNETH W. CRANGEL, ET AL.

By Douglas L. Weller
Douglas L. Weller
Reg. No. 30,506

April 13, 2004
Santa Clara, California
(408) 985-0642